IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
   Keohane et al.
Serial No: 10/777,646
Filed: 02/12/2004
 	
Title: AUTOMATED ELECTRONIC
MESSAGE FILING SYSTEM
 	
Docket Number:
AUS920030921US1
	Before Examiner:
	   MATTHEW KESSLER
	Group Art Unit: 2109
	
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<u>APPEAL BRIEF UNDER 37 CFR §41.37</u>

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     This Appeal Brief is submitted in support of the Appeal in the above-referenced application pursuant to a Notice of Appeal filed June 17, 2008 as required by 37 C.F.R. 41.31. This is an appeal from a final rejection dated March 18, 2008 of Claims 1, 5, 6, and 10-12 of application serial number 10/777,646, filed 02/12/2004.

I. Real Party in Interest

The real party in interest in the present application is the Assignee, International Business Machines Corporation of Armonk, New York, as evidenced by the Assignment set forth at Reel 014629, Frame 0899.

II. Related Appeals and Interferences

There are no Appeals or Interferences known to Appellant, Appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. No decisions have been rendered by a court or the Board in any related applications.

III. Status of Claims

1. Status of All Claims in Application

    a. Claims Rejected: 1, 5, 6, and 10-12.

    b. Claims Allowed or Confirmed: None.

    c. Claims Withdrawn from Consideration: None.

    d. Claims Objected to: None.

    e. Claims Cancelled: 2-4, 8, 9, and 13-19.

2. Claims on Appeal

    a. The claims being appealed are: 1, 5, 6, and 10-12.

    b. The claims being appealed stand finally rejected as noted by the Examiner in the Examiner's Action dated June 17, 2008. These rejected claims, which form the basis of this appeal, are reproduced in the attached Appendix.

IV. Status of Amendments

The Examiner finally rejected claims 1, 5, 6, and 10-12 in a final office action dated March 18, 2008. No amendments to claims 1, 5, 6, and 10-12, which are on appeal, were made following the final office action dated March 18, 2008.

V. Summary of Claimed Subject Matter

Claim 1 is directed to a method for providing electronic message filing recommendations. (Specification, page 1, paragraph 0009, lines 1-4). The method comprises the element of detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing the electronic message. (Specification, page 1, paragraph 0010, lines 1-5, paragraph 0011, lines 1-3, paragraph 0015, lines 1-11, page 3, paragraph 0040, lines 1-13, page 4, paragraph 0046, lines 1-5, page 4, paragraph 0054, lines 1-4, pages 4-5, paragraph 0057, lines 1-8, page 6, paragraph 0071, lines 1-4 and Figure 4, elements 400 and 404, Figure 9, element 906). In addition, the method comprises the element of attaching the at least one suggested folder name to the electronic message at the sender system for distribution to the recipient. (Specification, page 1, paragraph 0015, lines 1-11, page 3, paragraph 0040, lines 1-13, page 4, paragraph 0046, lines 1-5, page 4, paragraph 0054, lines 1-4, pages 4-5, paragraph 0057, lines 1-8, page 6, paragraph 0071, lines 14-17 and Figure 9, element 908). In addition, the method comprises the element of sending the electronic message with the suggested filing folder name from the sender system to a recipient system for the recipient. (Specification, page 1, paragraph 0015, lines 2-5, page 3, paragraph 0040, lines 1-11, page 4, paragraph 0046, lines 1-5). In addition, the method comprises the element of responsive to receiving the electronic message at the recipient system for the recipient, filtering the electronic message to detect the at least one suggested folder name specified by the sender in the electronic message for filing the electronic message from among a plurality of filing folders in a messaging filing directory. (Specification, page 3, paragraph 0043, lines 1-9, page 4, paragraph 0046, lines 5-10, page 4, paragraph 0049, lines 1-3 and Figure 11, element 1104). In addition, the method comprises the element of responsive to the recipient selecting to file the electronic message, automatically expanding a display directory of the plurality of filing folders to display the at least

one suggested folder in a graphically distinguishable format from the display of other folders of the plurality of filing folders, such that a recommendation of relevant folders for filing the electronic message is provided. (Specification, page 4, paragraph 0045, lines 1-12, page 4, paragraph 0050, lines 1-10, page 4, paragraph 0051, lines 1-4, page 4, paragraph 0052, lines 1-9, page 5, paragraph 0060, lines 1-6, and page 5, paragraph 0062, lines 1-6).

Claim 5 is directed to the method of claim 1 and is further directed to the element of responsive to detecting an icon for the particular electronic message dragged into a display region for the plurality of filing folders, automatically positioning the icon over the at least one suggested folder. (Specification, page 7, paragraph 0076, lines 1-13 and Figure 11, elements 1120 and 1122).

Claim 6 is directed to a system for providing electronic message filing recommendations. (Specification, page 1, paragraph 0009, lines 1-4). The system comprises a suggestion attachment controller at a sender system for detecting a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing the electronic message and for attaching the at least one suggested folder name to the electronic message for distribution to the recipient. (Specification, page 1, paragraph 0010, lines 1-5, paragraph 0011, lines 1-3, paragraph 0015, lines 1-11, page 3, paragraph 0040, lines 1-13, page 4, paragraph 0046, lines 1-5, page 4, paragraph 0054, lines 1-4, pages 4-5, paragraph 0057, lines 1-8, page 6, paragraph 0071, lines 1-4 and Figure 4, elements 400 and 404, Figure 9, element 906). In addition, the system comprises a communication controller for sending the electronic message from a sender system to a recipient system for the recipient. (Specification, page 4, paragraph 0053, lines 1-7). In addition, the system comprises a filtering controller at the recipient system, responsive to receiving the electronic message for the recipient, for filtering the electronic message to detect the at least one suggested folder name specified by the sender in the electronic message for filing the electronic message from among a plurality of filing folders in a messaging filing directory. (Specification, page 4,

paragraph 0049, lines 1-11). In addition, the system comprises an output controller at the recipient system, responsive to the recipient selecting to file the electronic message, for distinguishing the at least one suggested folder from a remainder of the plurality of filing folders, such that a recommendation of relevant folders for filing the electronic message is provided. (Specification, page 4, paragraph 0045, lines 5-12, page 4, paragraph 0051, lines 1-11, page 4, paragraph 0052, lines 1-9).

Claim 10 is directed to the system of claim 6 and is further directed to means responsive to detecting an icon for the particular electronic message dragged into a display region for the plurality of filing folders, for automatically positioning the icon over the at least one suggested folder. (Specification, page 7, paragraph 0076, lines 1-13 and Figure 11, elements 1120 and 1122).

Claim 11 is directed to a computer program product for providing electronic message filing recommendations. (Specification, page 2, paragraph 0032, lines 1-9). The computer program product comprises a recording medium. (Specification, page 2, paragraph 0032, lines 1-9). In addition, the computer program product is directed to means, recorded on the recording medium, for detecting a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing the electronic message. (Specification, page 2, paragraph 0031, lines 8-13, paragraph 0071, lines 1-4 and Figure 9, element 906). In addition, the computer program product is directed to means, recorded on the recording medium, for attaching the at least one suggested folder name to the electronic message for distribution to the recipient. (Specification, page 2, paragraph 0031, lines 8-13, paragraph 0071, lines 14-17 and Figure 9, element 908). In addition, the computer program product is directed to means, recorded on the recording medium, responsive to receiving the electronic message for the recipient, for filtering the electronic message to detect the at least one suggested folder name specified by the sender in the electronic message for filing the electronic message from among a plurality of filing folders in a messaging filing directory. (Specification, page 2,

paragraph 0031, lines 8-13, page 6, paragraph 0072, lines 9-11, page 6, paragraph 0074, lines 1-2 and Figure 10, element 1004, Figure 11, element 1104). In addition, the computer program product is directed to means, recorded on the recording medium, responsive to the recipient selecting to file the electronic message, for automatically expanding a display directory of the plurality of filing folders to display the at least one suggested folder in a graphically distinguishable format from the display of other folders of the plurality of filing folders, such that a recommendation of relevant folders for filing the electronic message is provided. (Specification, page 2, paragraph 0031, lines 8-13, page 6, paragraph 0075, lines 1-6 and Figure 11, element 1130).

Claim 12 is directed to the computer program product of claim 11 and is further directed to means, recorded on the recording medium, responsive to detecting an icon for the particular electronic message dragged into a display region for the plurality of filing folders, for automatically positioning the icon over the at least one suggested folder. (Specification, page 2, paragraph 0031, lines 8-13, page 7, paragraph 0076, lines 1-13 and Figure 11, elements 1120 and 1122).

VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 1, 6, and 11 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over over Scian (US Patent Publication 2006/0026236) in view of "Windows XP Automatically Expanding a Display Directory" (Microsoft).

2. Claims 5, 10, and 12 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over over Scian (US Patent Publication 2006/0026236) in view of "Windows XP Automatically Expanding a Display Directory" (Microsoft) and further in view of Michael Gleicher's article "Integrating Constraints and Direct Manipulation" (Gleicher).

VII. Argument

1.   35 U.S.C. 103(a), Alleged Obviousness under Scian in view of Microsoft, Claims 1, 6, and 11

The Final Office Action rejects 1, 6, and 11 under 35 U.S.C. §103(a) as being allegedly unpatentable over over Scian (US Patent Publication 2006/0026236) in view of "Windows XP Automatically Expanding a Display Directory" (Microsoft). [Final Office Action, p. 4]

As noted in the Office Action, under 35 USC §103(a) a patent may not be obtained though the invention is not identically disclosed as described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. In *Graham v. John Deere*, the Supreme Court clarified that "under 103, in considering the obviousness or nonobviousness of the subject matter, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved, in addition to evaluating evidence of secondary considerations." *Graham*, 383 U.S. 1, 148 USPQ 459 (1966).

The Examiner bears the initial burden of supporting any prima facie conclusion of obviousness. See *In re Rinehart*, 531, F.2d 1048, 189, USPQ 143 (CCPA 1976); *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007); MPEP 2142.   The key to supporting a rejection under 35 USC 103 is the clear articulation of the reasons why the claimed invention would have been obvious; the analysis supporting a rejection under 35 USC 103 should be made explicit. *See KSR International Co.*, 82 USPQ2d at 1396; MPEP 2142 (Rev. 6, Sept. 2007).

Appellants traverse the rejection of claims 1, 6, and 11. Appellants respectfully assert that the Office Action fails to establish a prima facie case of obviousness because the Office erred in the Graham factual findings and there is

no clear articulation of the rationale supporting a conclusion of obviousness. Because the Office Action fails to establish a prima facie case of obviousness, Appellants respectfully request withdrawal of the rejection under 35 USC 103(a) and allowance of the claims. The claims do not stand or fall together.

Claim 1

Claim 1 reads:

1.   A method for providing electronic message filing recommendations comprising:
        detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message;
        attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient;
        sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient;
        responsive to receiving said electronic message at said recipient system for said recipient, filtering said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory; and
        responsive to said recipient selecting to file said electronic message, automatically expanding a display directory of said plurality of filing folders to display said at least one suggested folder in a graphically distinguishable format from said display of other folders of said plurality of filing folders, such that a recommendation of relevant folders for filing said electronic message is provided.

Appellants respectfully assert that the Office has erred in finding a prima facie case of obviousness as to claim 1 because under a proper Graham analysis, when Scian and Microsoft are considered as a whole, the references do not teach the elements of claim 1 and there is no clear statement as to the rationale for one of ordinary skill in the art finding claim 1 as a whole obvious in view of the differences between Scian and Microsoft and claim 1.

detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message;

attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient;

sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient;

First, in the Graham inquiry, as to the scope and contents of Scian, the Final Office Action cites paragraph 0045 of Scian as reading on the element of <u>detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message</u>. The Final Office Action states that paragraph 0045 of Scian teaches "if the current message is an outgoing message, then the pre-selected folder 22 is presented as the folder in which the user can find the file to be attached to the current message. In both cases, of course, the user is free to override the pre-selection and to select another file folder." In addition, the Final Office Action states

> it is clearly taught that a user through an override can select a file folder for suggested filing purposes. In this instance Scian is speaking about messages with attachments, and it is interpreted that an attachment which is sent electronically is an electronic message. Further clarity is found when Scian teaches what happens when an incoming message with a preselected folder is received. Scian teaches in paragraph 0045 that "if the current message is an incoming message, then the pre-selected folder 22 is for storing the attachment. That is, if the user indicates that he or she wishes to save the attachment, then the system will present the preselected file as an easily executable option." It can be seen that the pre-selected folder is presented to the user as a choice for filing. Additionally, paragraph 0027 teaches the same method of selecting folders for the message without attachments. [Final Office Action, pp. 7-8]

In addition, as to the scope and contents of Scian, the Final Office Action cites paragraph 0045 of Scian as reading on <u>attaching said at least one</u> <u>suggested folder name to said electronic message at said sender system for</u> <u>distribution to said recipient</u> and states that paragraph 0045 of Scian describes "that a folder is selected and associated with the sent electronic message." [Final Office Action, p. 8]

Further, as to the scope and contents of Scian and Microsoft, the Final Office Action does not address any element of Scian or Microsoft that reads on <u>sending said electronic message with said suggested filing folder name from said</u> <u>sender system to a recipient system for said recipient</u>. The Final Office Action fails to specifically address this element in the rejection of claims.

Appellants respectfully submit that the Examiner has erred by not properly considering the content of Scian as a whole. In particular, the Examiner has considered portions of paragraphs 0027 and paragraph 0045 without considering Scian as a whole. In considering Scian as a whole, paragraph 0021 of Scian describes that a message includes message attributes, such as a subject attribute and a sender or recipient attribute, and a message body. Paragraph 0024 of Scian describes "a current message 24 is received by the communication module 26 and is stored temporarily in the storage module 28. The message comparison module 50 then compares the current message 24 with entries in either or both of the sender cache 54 or subject cache 56 to determine an entry having a message attribute 40 that matches a message attribute in the current message 24." More particularly, in paragraph 0025 of Scian, and Scian as a whole, Scian describes that for an incoming email, a hash is made of the sender name or subject line, and the hash is compared with a hash of the sender or subject line of emails already stored in folders by an email system. In Scian, paragraph 0025, and throughout, if there is a hash match between the incoming email hash and a hash of an already stored email entry, then the folder that the email entry is stored within is pre-selected for storage of the incoming email entry.

Next, in considering Scian as a whole, paragraph 0045 reads:

Say that the message comparison module 50 matches the hash code derived from the selected attribute of the current message with a hash code of an entry in the folder pre-selection cache 48. Then the folder pre-selection module 52 will pre-select the file folder identified by the file identifier of the matching entry. What this file folder is used for will depend on whether the current message is an incoming message or an outgoing message. If the current message is an incoming message, then the pre-selected folder 22 is for storing the attachment. That is, if the user indicates that he or she wishes to save the attachment, then the system will present the pre-selected file as an easily executable option. Alternatively, if the current message is an outgoing message, then the pre-selected folder 22 is presented as the folder in which the user can find the file to be attached to the current message.

When Scian as a whole is considered, rather than just portions of Scian taken out of context as presented in the Final Office Action, it is clear that paragraph 0045 of Scian describes the same system as described with reference to paragraph 0025, just configured to pre-select a file folder for attachments, not a message folder for a message. For outgoing messages, paragraph 0045 describes storing files in file folders that are "potentially attachable to messages" and presenting a "pre-selected folder 22" to the user for the folder with a hash of a message attribute matching the hash of file attachments stored the folder.

As to the elements of <u>detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message</u>, <u>attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient</u>, and <u>sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient</u>, the Final Office Action does not cite Microsoft as reading on any of these elements.

Second, in a Graham inquiry, in considering the differences between Scian and Microsoft and the elements of claim 1, Appellants respectfully submit that even if Scian paragraph 0045 is only narrowly considered as in the Final Office Action as describing "identifying a pre-selected folder for storing a file

attachment for an incoming message", the Examiner has erred in concluding that this teaches detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message. In addition, clearly when Scian is viewed as a whole, Scian's description in paragraphs 0044 and 0045 of matching the hash of a message attribute of a received message with a hash of an entry within a folder to pre-select that folder does not teach the claimed elements of a sender of a message selecting a suggested folder name for the recipient receiving the electronic message to then select as a folder name for the recipient filing of the electronic message.

In addition, in considering the differences between Scian and Microsoft and the element of attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient of claim 1, Appellants respectfully submit that no portion of paragraph 0045 of Scian actually states "that a folder is selected and associated with the sent electronic message" as asserted in the Final Office Action. In addition, Appellants respectfully submit that Scian describes either (1) for an incoming message a pre-selected folder, where the pre-selected folder is based on matching the hash of an attribute from the message with a hash of an entry in a folder, is used for storing the attachment; or (2) for an outgoing message the pre-selected folder is presented as the folder in which the user can find the file to be attached to the current message. Neither paragraph 0045 of Scian, or any other portion of Scian, teach attaching a suggested folder name selected by a sender, to an outgoing message, for distribution to a recipient.

Further, in considering the differences between Scian and Microsoft and the element of sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient, Appellants respectfully note that the Examiner has erred in the rejection by failing to consider all the words in a claim in judging the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA

1970). As previously noted, the Final Office Action does not address the element of <u>sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient</u> in the rejection of the claim. In addition, Appellants respectfully submit that when claim 1 is considered as a whole, claim 1 teaches sending an electronic message from a sender system to a recipient with a suggested filing folder name attached to the electronic message, where the sender specified the suggested filing folder name and that a difference between Scian and Microsoft and claim 1 is that the electronic message attachment in Scian does not teach sending an electronic message with a suggested filing folder name attached.

Therefore, in view of the scope and content of Scian and Microsoft and the differences between Scian and Microsoft and claim 1, it is clear that the differences between Scian and Microsoft and claim 1 are not such that claim 1 as a whole would have been obvious to one with skill in the art at the time of the invention, and therefore the Final Office Action fails to establish a prima facie case of obviousness as to claim 1. In particular, regardless of the Examiner's stated rationale for obviousness, it is clear that the gap between the prior art and claim 1 is so wide as to render the claims nonobvious to one of ordinary skill in the art. Clearly, Scian does not teach a user interface through which to detect a sender selection of a suggested filing folder for a recipient of an electronic message to use in filing the electronic message, attaching the suggested filing folder to the electronic message, or sending the electronic message to the recipient with the attached suggested filing folder. In addition, there is no modification proposed in the Final Office Action for Scian to teach these elements.

Because a proper Graham factual findings indicate differences between Scian and Microsoft and claim 1 and no clear articulation of the reasons why the claimed invention of claim 1 would have been obvious is provided, the Office erred in finding prima facie obviousness as to claim 1. MPEP 2141, IV. Because the Office fails to find prima facie obviousness as to claim 1, Appellants

respectfully request withdrawal of the rejection under 35 USC 103(a) and allowance of the claims.

responsive to receiving said electronic message at said recipient system for said recipient, filtering said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory

First, in a Graham inquiry, in considering the scope and contents of Scian, the Final Office Action cites paragraph 0045 of Scian as reading on <u>responsive to receiving said electronic message at said recipient system for said recipient, filtering said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory</u>. [Final Office Action, p. 8] The Final Office Action states that paragraph 0045 of Scian describes "if the current message is an incoming message, then the pre-selected folder 22 is for storing the attachment. That is, if the user indicates he or she wishes to save the attachment, then the system will present the pre-selected file as an easily executable option." The Final Office Action also states "in this case the pre-selected folder is presented to the user for suggested filing. In this instance Scian is speaking about messages with attachments, and it is interpreted that an attachment which is sent electronically is an electronic message. Additionally paragraph 0027 teaches the same method of selecting folders for the message with or without attachments." [Final Office Action, pp. 8-9]

Appellants respectfully submit, that as previously noted, when paragraphs 0025, 0027, 0044, and 0045 are considered, in view of Scian as a whole, Scian describes matching a hash code of a message attribute with a hash code of an entry already in a folder. Matching a hash code of an incoming message attribute with a hash code of an entry already in a folder does not teach receiving an electronic message and filtering the electronic message to detect a suggested folder name specified by the sender of the electronic message.

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The Final Office Action does not cite any portion of Microsoft reading on responsive to receiving said electronic message at said recipient system for said recipient, filtering said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory.

Therefore, in considering the differences between Scian and Microsoft and claim 1, Appellants respectfully submit that when Scian is considered as a whole, there is no portion of Scian with regard to an incoming message that describes selecting the folder for storing an incoming email message based on matching a suggested folder name specified by a sender of the message with the same named folder in a message filing directory. Therefore, clearly, Scian does not teach the element of responsive to receiving said electronic message at said recipient system for said recipient, filtering said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory

Therefore, in view of the scope and content of Scian and Microsoft and the differences between Scian and Microsoft and claim 1, it is clear that the differences between Scian and Microsoft and claim 1 are not such that claim 1 as a whole would have been obvious to one with skill in the art at the time of the invention, and therefore the Final Office Action fails to establish a prima facie case of obviousness as to claim 1. In particular, regardless of the Examiner's stated rationale for obviousness, it is clear that the gap between the prior art and claim 1 is so wide as to render the claims nonobvious to one of ordinary skill in the art. Clearly, Scian does not teach filtering an incoming electronic message to detect a suggested folder name attached to the electronic message specified by the sender for filing the electronic message in a filing folder of a messaging filing directory at the recipient system. In addition, there is no modification proposed in the Final Office Action for Scian to teach these elements.

Because a proper Graham factual findings indicate differences between Scian and Microsoft and claim 1 and no clear articulation of the reasons why the claimed invention of claim 1 would have been obvious is provided, the Office erred in finding prima facie obviousness as to claim 1. MPEP 2141, IV. Because the Office fails to find prima facie obviousness as to claim 1, Appellants respectfully request withdrawal of the rejection under 35 USC 103(a) and allowance of the claims.

Claims 6 and 11

Claims 6 and 11 are rejected for the same reasons as claim 1. Appellants respectfully submit that these claims are also not obvious under 103(a) in view of Scian and Microsoft for at least the same reasons that claim 1 is not obvious under 103(a) in view of Scian and Microsoft.

2. 35 U.S.C. 103(a), Alleged Obviousness under Scian in view of Microsoft and Gleicher, Claims 5, 10, and 12

The Final Office Action rejects 5, 10, and 12 under 35 U.S.C. §103(a) as being allegedly unpatentable over over Scian (US Patent Publication 2006/0026236) in view of "Windows XP Automatically Expanding a Display Directory" (Microsoft) and further in view of Michael Gleicher's article "Integrating Constraints and Direct Manipulation" (Gleicher). [Final Office Action, pp. 9-10]

Appellants respectfully assert that because claims 1, 6, and 11 are nonobvious under 35 USC 103(a), claims 5, 10, and 12 which depend on claims 1, 6, and 11 are also nonobvious and should be allowed. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

CONCLUSION

It is therefore respectfully requested that the Examiner's rejection of claims 1, 5, 6, and 10-12 under 35 U.S.C. §103(a) be reversed and the claims allowed.

Please charge the fee of $500.00 for submission of an Appeal Brief under

37 CFR 41.20(b)(2) to IBM Corporation Deposit Account No. 09-0447. No additional filing fee is believed to be necessary; however, in the event that any additional fee is required, please charge it to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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VIII. Claims Appendix

The Claims involved in the Appeal are as follows:

1.   A method for providing electronic message filing recommendations comprising:

detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message;

attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient;

sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient;

responsive to receiving said electronic message at said recipient system for said recipient, filtering said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory; and

responsive to said recipient selecting to file said electronic message, automatically expanding a display directory of said plurality of filing folders to display said at least one suggested folder in a graphically distinguishable format from said display of other folders of said plurality of filing folders, such that a recommendation of relevant folders for filing said electronic message is provided.

5.   The method according to claim 1 for providing electronic message filing recommendations, further comprising:

responsive to detecting an icon for said particular electronic message dragged into a display region for said plurality of filing folders, automatically positioning said icon over said at least one suggested folder.

6.   A system for providing electronic message filing recommendations comprising:

a suggestion attachment controller at a sender system for detecting a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message and for attaching said at least one suggested folder name to said electronic message for distribution to said recipient;

a communication controller for sending said electronic message from a sender system to a recipient system for said recipient;

a filtering controller at said recipient system, responsive to receiving said electronic message for said recipient, for filtering [[an]] said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory; an

an output controller at said recipient system, responsive to said recipient selecting to file said electronic message, for distinguishing said at least one suggested folder from a remainder of said plurality of filing folders, such that a recommendation of relevant folders for filing said electronic message is provided.

10.   The system according to claim 6 for providing electronic message filing recommendations, further comprising:

means responsive to detecting an icon for said particular electronic message dragged into a display region for said plurality of filing folders, for automatically positioning said icon over said at least one suggested folder.

11.   A computer program product for providing electronic message filing recommendations comprising:

a recording medium;

means, recorded on said recording medium, for detecting a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message;

means, recorded on said recording medium, for attaching said at least one suggested folder name to said electronic message for distribution to said recipient;

means, recorded on said recording medium, responsive to receiving said electronic message for said recipient, for filtering [[an]] said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory; and

means, recorded on said recording medium, responsive to said recipient selecting to file said electronic message, for automatically expanding a display directory of said plurality of filing folders to display said at least one suggested folder in a graphically distinguishable format from said display of other folders of said plurality of filing folders, such that a recommendation of relevant folders for filing said electronic message is provided.

12.   The computer program product according to claim 11 further comprising:

means, recorded on said recording medium, responsive to detecting an icon for said particular electronic message dragged into a display region for said plurality of filing folders, for automatically positioning said icon over said at least one suggested folder.

IX. Evidence Appendix

There is no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner that is relied upon by Appellants in the appeal.

X. Related Proceedings Appendix

There are no decisions rendered by a court or the Board in any related appeals.